



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/685,745

10/15/2003

Lukas Eisermann

31132.154

6136

46333 7590 10/11/2007
HAYNES AND BOONE, LLP
901 MAIN ST
SUITE 3100
DALLAS, TX 75202

EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

10/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/685,745

Applicant(s)

EISERMANN, LUKAS

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14,23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-7,13,14,23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrington (5,893,889).

With respect to claims 1, 13,27, Harrington discloses a disc replacement device comprising a shell (32), a fulcrum (46), wherein the fulcrum is an entirely spherical ball bearing, as set forth in column 1, line 66, having a substantially spherical surface; and a damping sleeve (54,68), as best seen in FIG.2, wherein the shell comprises a first surface (69 or the flat surface of 69) adapted for articulation with the fulcrum the first surface having a first surface shape (the flat of 69) different from the spherical surface and a second surface adapted for coupling with the damping sleeve (at 56 in FIG.2); the first surface being separated from the second surface, as best seen in FIG.2. Wherein the damping sleeve is configured to produce a cavity for receiving a lubricating medium; as set forth in 3, lines 64-67, column 4, lines 1-12.

With respect to claims 3-7,14,23-26, Harrington discloses all the limitations; as set forth in column 2, lines 55-67, column 3, lines 1-67, column 4, lines 1-50, and as best seen in FIG.2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington (5,893,889) in view of Gauchet et al. (6,733,532).

With respect to the above claims, it is noted that Harrington did not teach the preferred material, as claimed by applicant. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any of the preferred material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In Leshin, 125 USPQ 416. Also see last office action for the use of these materials in the art.

It is also noted that Harrington did not teach of a damping sleeve comprising shape memory alloys; as claimed by applicant. However, in a similar art, Gauchet et al, column 3, lines 27-32) evidences the use of a shell and a damping sleeve comprising shape memory alloys so that the device has a certain axial rigidity and be deformed or be twisted about any axis.

Therefore, given the teaching of Gauchet, it would have been obvious to one having ordinary skill in the art at the time invention was made to modify the device of Harrington; as taught by Gauchet et al. so that the device has a certain axial rigidity and be deformed or be twisted about any axis.

Response to Amendment

Applicant's arguments filed 8/17/07 have been fully considered but they are not persuasive. Applicant stated that Harrington did not teach of a fulcrum that is an entirely spherical ball bearing. The examiner begs to differ, in column 1, line 66, Harrington discloses "A generally spherical pivot ball on a post.....". Therefore, the spherical ball of Harrington is wholly or entirely spherical, since Harrington discloses that the spherical ball is separated from the post. Applicant has not presented any convincing argument to demonstrate the difference between applicant's spherical ball and Harrington's spherical ball. Nowhere did Harrington state that the ball is partially spherical, except that applicant in his arguments keeps stating that the spherical ball of Harrington is partially spherical.

As to applicant's argument concerning claim 12, a new ground of rejection is herein made in view of Gauchet et al. Gauchet discloses a damper comprising a cushion made of viscoelastic material, for example silicone, the cushion additionally comprises a bellows or damper made of titanium or titanium alloy that has a shape memory.

As to the argument concerning claim 13, applicant's attention is directed to Harrington, column 3, lines 64-67 and column 4, lines 1-13 where a cavity in the device is disclosed. This cavity is fully capable of receiving a lubrication medium; as claimed by applicant.

Conclusion

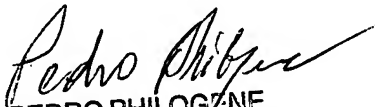
A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
September 28, 2007


PEDRO PHILOGENE
PRIMARY EXAMINER